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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,037	02/18/2000	SYLVAIN ORENGA	105454	7665

25944 7590 10/23/2002

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EXAMINER
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NAVARRO, ALBERT MARK

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 10/23/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/486,037

Applicant(s)

Orenga

Examiner

Mark Navarro

Art Unit

1645



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, and 13-19 is/are rejected.
- 7) ☒ Claim(s) 5, 9-12, and 20-28 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 1645

**DETAILED ACTION**

Applicant's amendment filed August 9, 2002 (Paper Number 13) has been received and entered. Claims 1-28 are pending in the instant application.

All grounds of rejection in the office action mailed February 11, 2002 are withdrawn.

The following new grounds of rejection are applied to the claims:

***Claim Rejections - 35 USC § 112***

1. Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 2-3, the phrase "optionally" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Art Unit: 1645

2. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is vague and indefinite in the recitation of “in that the activator consists of... and/or... and or...” One of skill in the art would be unable to determine the metes and bounds of the claimed invention. For instance the transitional phrase “consists” is deemed to be closed and include only what is recited. However Applicant’s language leaves one of skill in the art to guess the identity of what is included in the medium based upon the multiple “and/or” recitations. Without a clear idea of what is encompassed by the term consisting of one of skill in the art would be unable to determine the metes and bounds of the claimed invention.

3. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is vague and indefinite in the recitation of a “derivative.” One of skill in the art would be unable to determine the metes and bounds of a derivative. Since it is unclear how the protein is altered to form a derivative referred to in the claims, there is no way for the person of skill in the art to ascribe a discrete and identifiable class of compounds which are derivatives.

Art Unit: 1645

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaneko et al.

The claims are drawn to culture medium for the specific identification and/or differentiation of *Candida albicans* and *Candida tropicalis* yeast, comprising a chromogenic or fluorogenic substrate, which can be hydrolyzed by an enzyme of the hexosaminidase family,

Art Unit: 1645

wherein the medium also comprises at least one compound that selectively inhibits the hexosaminidase activity of *C. tropicalis*.

Kaneko et al (U.S. Patent Number 5,272,072) disclose of a composition comprising 5-bromo-4-chloro-3-indolyl- $\beta$ -D-glucuronic acid and dimethyl formamide. (See column 9).

In view that 5-bromo-4-chloro-3-indolyl- $\beta$ -D-glucuronic is a chromogenic substrate that can be hydrolyzed by an enzyme of the hexosaminidase family and that dimethyl formamide selectively inhibits the hexosaminidase activity of *C. tropicalis*, the disclosure of Kaneko et al is deemed to anticipate the claimed invention.

It is noted that Kaneko et al do not disclose culturing *Candida* with the composition, however culturing *Candida* with the composition is merely an intended use of the composition and therefore carries no patentable weight.

5. Claims 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Wong-Madden et al.

The claims are drawn to medium for the specific identification and/or differentiation of *Candida albicans* and *Candida tropicalis* yeasts, wherein said medium comprises two substrates, a first chromogenic or fluorogenic substrate that can be hydrolyzed by an enzyme from the hexosaminidase family, and a second chromogenic or fluorogenic substrate that can be hydrolyzed by an enzyme from the glucosidase family.

Art Unit: 1645

Wong-Madden (U.S. Publication 2002/0137176) disclose of multiple chromogenically labeled substrates in a composition. (See pages 6-9).

In view that Wong-Madden disclose of multiple chromogenically labeled substrates that can be hydrolyzed by an enzyme from the hexosaminidase family, and chromogenically labeled substrates that can be hydrolyzed by an enzyme from the glucosidase family, the disclosure of Wong-Madden et al is deemed to anticipate the claimed invention.

Claims 5, 9-12, and 20-28 are objected to as depending upon a rejected base claim, however claims 5, 9-12 and 20-28 are free of the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Navarro, whose telephone number is (703) 306-3225. The examiner

Application/Control Number: 09/486,037

Page 7

Art Unit: 1645

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1645 by facsimile transmission. Papers should be faxed to Group 1645 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the official Gazette 1096 OG 30 (November 15, 1989). The CMI Fax Center number is (703) 308-4242.



Mark Navarro

Primary Examiner

October 16, 2002